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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,160	09/11/2003	Daniel Joseph Heithoff	ROC920030088US1	7388
30206 7590 03/06/2009				
IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER				
STIBLEY, MICHAEL R				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
03/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/660,160

**Applicant(s)**

HEITHOFF ET AL.

**Examiner**

MICHAEL R. STIBLEY

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Response to Arguments***

1. Applicant's remarks of 12/02/2008 are based on the newly amended claims and such arguments are fully addressed in the present Office Action as featured below.

Applicant contends that the recitation of claim 1, namely, "sending the associated recommended offering and an identification of a marketing channel to the client and sending a notification to the marketing channel" transforms the client and the marketing channel into a different state. Examiner is not persuaded by this argument. A claimed process is patent-eligible under §101 if: (1) it is tied to a **particular** machine or apparatus or (2) it transforms a **particular** article into a different state or thing. See Benson 490 U.S. at 70. A client nor a marketing channel is a **particular article** nor are they transformed to a different state or thing.

Additionally, Applicant has amended claim 1 to read "A computer implemented method comprising". Amending the preamble to include computer does not tie the claim to a particular machine, as the body of the claim needs to include the particular machine so as to ensure that insignificant extra-solution activity is not the sole purpose of the machine. It is also not clear whether the computer is performing any steps at all.

Therefore, Applicant's request for allowance and withdraw of the most previous Office Action have been carefully considered and respectfully denied in view of the current response. **Thus, the current Office Action is made FINAL.**

**DETAILED ACTION**

2. This Office Action is in response to the claim amendments and remarks filed on 12/02/2008.

### CLAIM STATUS

3. Claims 1-5 and 22-25 are currently pending in the instant application and have been examined.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-5 and 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**As per Claims 1-5 and 22-25:** Claims 1-5 and 22-25 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The claims (or at least independent claims 1, uncured by the dependent claims) are related to manual processes, which is not patentable. Indeed, the claims (e.g. claims 1) recite a process, which is not tied to a particular machine nor transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*. See also the following U.S. Supreme Court cases: *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). The claims are not tied to a particular machine.

Examiner suggests that Applicant incorporates computer architecture (hardware) into the body of the claims in a non-nominal (i.e. not insignificant extra-solution activity) way so that the

claim positively recites the particular machine to which it is tied, e.g., by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, e.g., the material being changed to a different state.

Examiner further notes that the *Dichr* Court stated that “insignificant post-solution activity will not transform an unpatentable principle into a patentable process. 450 U.S. at 191-192.

Examiner further notes that The Court in Flook, 437 U.S. at 590 stated “The notion that post-solution activity, no matter how conventional or obvious in itself, can transform an unpatentable principle into a patentable process exalts form over substance.” Flook further outlines that the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. Further, the inherent step of gathering data can also fairly be characterized as insignificant extra-solution activity See Flook, 437 U.S. at 590.

Examiner further notes the publication of *In re Bilski*, 88 USPQ2d 1385.

Examiner notes that Applicant may show that a process claim satisfies §101 either by showing that Applicant's claim is tied to a particular machine, or by showing that Applicant's claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-5 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Suellen Kae Birkholz et al (BIRKHOLZ)(United States Patent 7,055,149 B2).**

**As per Claim 1: BIRKHOLZ teaches:** A computer implemented method comprising:

See at least "...Fig 1 is a diagram of a networked environment generally defining a relationship between a computer system customer/owners side and a computer system supplier side...The computer systems may be any computerized device including personal computers (PCs), workstations, servers, wireless devices, personal digital assistants (PDAs), and the like..." Col 4 lines 50-67; see also Fig 1

receiving data from a client upon an occurrence of an event, wherein the data comprises a plurality of fields,

See at least Fig 38; See also "...receiving, by a supplier system, a software inventory from the customer system..." Col 2 lines 15-17 See also "...the software sales representative must determine the software inventory currently installed on the customer system..." Col 1 lines 45-47 See also "...machine software inventory is sent directly from the selected hardware of the customer system as directed by the customer..." Col 28 lines 60-65 See also "...The GUI may have a variety of fields with default entries compiled from customer/product registration information..." Col 32 lines 44-50

and wherein the event is selected from a group consisting of installation of hardware at the client, installation of software at the client, detection of a performance problem at the client, and detection of an error at the client;

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also "...performance data..." Column 19 lines 19-32 See also Fig 12 See also "...the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware information (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages..." Col 23 lines 45-50

comparing a subset of the plurality of fields to a plurality of thresholds via a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the plurality of thresholds to values in subset of the plurality of fields, and specify an associated recommended offering,

See at least "...the system sizer employs a system model selection function, referred to as the comparison tool, to construct the set of all systems capable of meeting the system capacity requirements..." Col 7 lines 45-50 See also Fig 9 and Col 12 lines 17-41 See also "...recommendation table..." Col 12 lines 1-16

wherein the subset of the plurality of fields of the data comprises a trend at the client, wherein the trend comprises a rate of growth of consumption of a resource at the client and an estimated time period until the resource is constrained;

See at least "...memory growth trend field..." Col 15 lines 25-30 See also "...estimated system attributes entry and a time period entry..." Col 12 lines 5-6

and when the plurality of conditions are met by the comparing of the values in the subset of the plurality of fields to the plurality of thresholds, sending the associated recommended offering and an identification of a marketing channel to the client and sending a notification to the marketing channel, wherein the notification comprises a request to receive information regarding why the recommended offering was made.

See at least Fig 38 element 3830 "Why should I use IBM Electronic Services FRO AS/400? See at least Fig 18 and "...a system recommendation GUI. The GUI contain system recommendation information resulting from the recommend table and which will be passed to the comparison tool..." Col 15 lines 50-67

Examiner notes: Please consider entirety of reference.

As per **Claim 2: BIRKHOLZ** teaches: The method of claim 1, wherein the associated recommended offering further comprises an offer for a service.

See at least Col 24 lines 55-60

**As per Claim 3: BIRKHOLZ** teaches: The method of claim 1, wherein the data comprises a hardware inventory of the client.

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also "...performance data..." Column 19 lines 19-32 See also Fig 12 See also "...the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages..." Col 23 lines 45-50

**As per Claim 4: BIRKHOLZ** teaches: The method of claim 1, wherein the data comprises a software inventory of the client.

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also "...performance data..." Column 19 lines 19-32 See also Fig 12 See also "...the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages..." Col 23 lines 45-50

**As per Claim 5: BIRKHOLZ** teaches: The method of claim 1, wherein the data comprises a performance inventory of the client.

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also "...performance data..." Column 19 lines 19-32 See also Fig 12 See also "...the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware information (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages..." Col 23 lines 45-50

**As per Claim 22: BIRKHOLZ** teaches: The method of claim 1, further comprising: saving a history of the inventory as the inventory changes over time.

See at least "...at some time interval (monthly) the historical summary server operates to merge the summarized agent data with older history data (previously collected from the same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

**As per Claim 23: BIRKHOLZ** teaches: The method of claim 22, wherein the comparing further comprises: comparing a plurality of records in the history.

See at least "...at some time interval (monthly) the historical summary server operates to merge the summarized agent data with older history data (previously collected from the same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

**As per Claim 24: BIRKHOLZ** teaches: The method of claim 1, wherein the associated recommended offering comprises an offer for hardware.

See at least Col 17 lines 1-7

As per Claim 25: BIRKHOLZ teaches: The method of claim 1, wherein the receiving further comprises: periodically receiving updates to the data from the client.

See at least Col 7 lines 1-16

*Conclusion*

8. **THIS ACTION IS MADE FINAL** See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/  
Examiner, Art Unit 3688  
Friday, February 27, 2009

*/Jean Janvier/  
Primary Examiner, Art Unit 3688*